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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,461	01/08/2002	Michael Joseph Calderaro	AUS920010790US1	4159

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IBM CORPORATION- AUSTIN (JVL)  
C/O VAN LEEUWEN & VAN LEEUWEN  
PO BOX 90609  
AUSTIN, TX 78709-0609

EXAMINER

BOYCE, ANDRE D

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/042,461

Applicant(s)

CALDERARO ET AL.

Examiner

Andre Boyce

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-20 have been examined.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the evaluation templates" in line 7 of the claim.

There is insufficient antecedent basis for this limitation in the claim. Claims 2-7 are rejected based upon the same rationale, since they depend therefrom.

Claim 8 recites the limitation "the evaluation templates" in line 14 of the claim.

There is insufficient antecedent basis for this limitation in the claim. Claims 9-13 are rejected based upon the same rationale, since they depend therefrom.

Claim 14 recites the limitation "the evaluation templates" in line 9 of the claim.

There is insufficient antecedent basis for this limitation in the claim. Claims 15-20 are rejected based upon the same rationale, since they depend therefrom.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Band et al (Strategic Downsizing, 1995), in view of Haq et al (USPN 6,275,812).

As per claim 1, Band et al disclose a method of reducing employee resources through a planned resource reduction (i.e., company downsizing, ¶ 19), said method comprising: identifying a surplus skill group (i.e., conducting a skills analysis and matching existing skills of the workforce to skills needed, ¶¶ 21-22). Band et al does not disclose creating at least one evaluation template for the identified skill group, wherein each evaluation template includes one or more review factors; and storing the evaluation templates in a data store. Haq et al disclose specific job functions in a specialty identified by a skills template, including the relevant importance of each skill and the required skill level to perform the job function (column 5, lines 25-29), wherein the templates are stored in a database (column 5, lines 64-66). Both Band et al and Haq et al are concerned with effective employee assessment, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include creating at least one evaluation template for the identified skill group, wherein each evaluation template includes one or more review factors; and storing the evaluation templates in Band et al, as seen in Haq et al, thereby providing an effective appraisal system to determine desired skills of employees in the Band et al system (see Band et al, ¶ 40).

As per claim 2, Band et al disclose selecting an employee for surplus evaluation (i.e., determine a candidate for departure, ¶ 40); and retrieving employee data corresponding to the selected employee, wherein the employee data includes a skill group for the selected employee (i.e., skills needs analysis, including an appraisal system to identify those with desired skills, ¶ 40). Band et al does not disclose locating one of the evaluation skill templates corresponding to the retrieved skill group; evaluating the selected employee using the located evaluation template; and storing the evaluation of the selected employee in a second data store. Haq et al disclose assessing the suitability of an employee, for a particular job assignment, from the skills assessment forms in the database against the given skill template for a job function (column 6, lines 13-17). Both Band et al and Haq et al are concerned with effective employee assessment, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include locating one of the evaluation skill templates corresponding to the retrieved skill group; evaluating the selected employee using the located evaluation template; and storing the evaluation in Band et al, as seen in Haq et al, thereby providing an effective appraisal system to determine desired skills of employees in the Band et al system (see Band et al, ¶ 40).

As per claim 3, Band et al does not disclose retrieving one or more pre-existing evaluation templates; and copying one or more pre-existing review factors from the pre-existing evaluation templates to the evaluation template.

Haq et al disclose a manager looking up the available skills template and picking one that closely matches the job function and making changes in the template to make it suitable for the requirements of the job, thus creating a modified template (column 6, lines 1-4). Both Band et al and Haq et al are concerned with effective employee assessment, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include retrieving one or more pre-existing evaluation templates; and copying one or more pre-existing review factors from the pre-existing evaluation templates in Band et al, as seen in Haq et al, thereby providing an effective appraisal system to determine desired skills of employees in the Band et al system (see Band et al, ¶ 40).

As per claim 4, Band et al disclose receiving a skill group identifier from a user (i.e., critical and desired skills, ¶ 40). Band et al does not disclose comparing the skill group identifier to a plurality of stored identifiers, wherein each stored identifier corresponds to a stored evaluation template; and identifying the pre-existing evaluation templates from the plurality of stored evaluation templates based on the comparison. Haq et al disclose the skills templates indicating the skills required to perform a particular job function, wherein the templates can be used as guidelines in comparing job functions (column 5, lines 37-47). Both Band et al and Haq et al are concerned with effective employee assessment, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include comparing the skill group identifier to a plurality of stored identifiers, wherein each stored identifier corresponds to a stored

evaluation template; and identifying the pre-existing evaluation templates from the plurality in Band et al, as seen in Haq et al, thereby providing an effective appraisal system to determine desired skills of employees in the Band et al system (see Band et al, ¶ 40).

As per claim 5, Band et al does not disclose storing the evaluation templates in a database managed by a database management system. Haq et al disclose the templates stored in a database (column 5, lines 64-66). Both Band et al and Haq et al are concerned with effective employee assessment, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include storing the evaluation templates in a database managed by a database management system in Band et al, as seen in Haq et al, thereby providing an effective appraisal system to determine desired skills of employees in the Band et al system (see Band et al, ¶ 40).

As per claim 6, Band et al does not disclose receiving one or more job levels corresponding to the identified skill group; and creating one of the evaluation templates for each skill group and job level combination. Haq et al disclose specific job functions in a specialty identified by a skills template, including the relevant importance of each skill and the required skill level to perform the job function (column 5, lines 25-29). Both Band et al and Haq et al are concerned with effective employee assessment, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include receiving one or more job levels corresponding to the identified skill group; and

creating one of the evaluation templates for each skill group and job level combination in Band et al, as seen in Haq et al, thereby providing an effective appraisal system to determine desired skills of employees in the Band et al system (see Band et al, ¶ 40).

As per claim 7, Band et al disclose receiving a skill group identifier from a user (i.e., critical and desired skills, ¶ 40); retrieving one of the evaluation templates based on the skill group identifier; modifying at least one of the review factors included in the retrieved evaluation template in response to one or more modification requests; and storing the modified evaluation template in the data store. Haq et al disclose a manager looking up the available skills template and picking one that closely matches the job function and making changes in the template to make it suitable for the requirements of the job, thus creating a modified template (column 6, lines 1-4). Both Band et al and Haq et al are concerned with effective employee assessment, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include retrieving one of the evaluation templates based on the skill group identifier; modifying at least one of the review factors included in the retrieved evaluation template in response to one or more modification requests in Band et al, as seen in Haq et al, thereby providing an effective appraisal system to determine desired skills of employees in the Band et al system (see Band et al, ¶ 40).



Claims 8-13 are rejected based upon the rejections of claims 1-4, 5, and 6, respectively, since they are the system claims corresponding to the method claims.

Claims 14-21 are rejected based upon the rejections of claims 1-7, respectively, since they are the computer program product claims corresponding to the method claims.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Lindia et al (US 2002/0184085) disclose a fully automated employee review system.

-Mactas et al (US 2002/0143496) disclose an economic value assigned to an individual's contribution.

-Magrino et al (US 2002/0198766) disclose human capital management system.

-Desanti et al (US 2003/0120537) disclose enhancing the performance of marginal employees.

-Ibarra (USPN 6119097) disclose enabling a supervisor to quantify job performance characteristics.

-Lacy et al (USPN 6524109) disclose an improved skill set assessment system.


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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571) 272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

adb  
March 17, 2006

  
ANDRE BOYCE  
PATENT EXAMINER  
A.U. 3623